

Remarks

Claims 1-20 are pending in the application and are presented for reconsideration. Claims 1, 8, 17, and 19 have been amended. Claims 2-7, 9-16, 18 and 20 remain in the application unchanged. No new matter has been added.

Claim Rejections

Claims 1-16, 19 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jacobowitz et al. (U.S. Pat. No. 5,304,969).

Claims 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacobowitz et al. in view of Bossard et al. (U.S. Pat. No. 4,805,979).

The Examiner's rejections of the claims are respectfully traversed.

I. Response to Rejections of Claims

a. Claims 1-7

Applicant's claim 1 recites:

A cable routing tray for routing external cabling of an electronic device, comprising:

a body;

a cable routing channel formed on said body, said cable routing channel comprising an ingress configured to receive an external cable, an egress configured to output said external cable, a guiding path between said ingress and said egress, a retainer configured to retain said external cable in said guiding path when said external cable is routed through said guiding path between said ingress and said egress, and an aperture configured to allow removal of the external cable without removal of the retainer.

The Jacobowitz Reference

The Examiner cites Jacobowitz as anticipating claim 1. In particular, the Examiner seeks to equate the Thermal Conduction Module (TCM) 10 of Jacobowitz with Applicant's recited "body", the guide member 169 of Jacobowitz with Applicant's recited "cable routing channel", cable 23 of Jacobowitz with Applicant's "cable", retainer 30 of Jacobowitz with Applicant's "retainer configured to retain said external cable in said guiding path when

said external cable is routed through said guiding path between said ingress and said egress”, and an unnumbered aperture in Fig. 6 of Jacobowitz with Applicant’s “aperture”.

Jacobowitz does not teach or suggest “an aperture configured to allow removal of the external cable without removal of the retainer” as recited in Applicant’s claim 1. If the retainer 30 in Jacobowitz is to be equated with Applicant’s recited “retainer configured to retain said external cable in said guiding path when said external cable is routed through said guiding path between said ingress and said egress”, then in order for Jacobowitz to also meet the limitation of “an aperture configured to allow removal of the external cable without removal of the retainer”, there must be shown somewhere in Jacobowitz an aperture configured to allow removal of the cable 23 from the channel 169 without removal of the retainer 30. However, as clearly shown in FIGS. 2 and 3 of Jacobowitz and described in Jacobowitz at least at Col. 6, lines 58-65, cable 23 cannot be removed from the channel 169 (i.e., the alleged equivalent of Applicant’s recited “guiding path”) without removing the retainer 30. Thus, Jacobowitz does not meet this limitation.

In response to the Applicant’s arguments filed 23 August 2005, the Examiner states that the limitation that the apparatus is for routing external cables has not been given patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response, Claims 1, 5, 17 and 19 have each been amended to remove the “intent of use” language and to add functional language to the claimed structure. It has been held, and there is ample precedent to establish, that functional limitations are appropriate in claims and should be afforded patentable weight by the Examiner for determining anticipation. See, e.g., *In re Land*, 151 USPQ 621 at 635-636 (CCPA 1966) (emphasis in original) (“It is true that the italicized portions [of claim 70] are “functional” but we do not regard that as good ground to give them “no weight” in view of the

third paragraph [currently the sixth paragraph] of 35 U.S.C. § 112. We give them weight and with this limitation with think claims 70 and 71 are limited to deferred diffusion *built into the structure recited*, thereby being limited to the actual invention disclosed and hence allowable for the same reasons given by the board...."); *In re Ludtke*, 169 USPQ 563, 566 (CCPA 1971) ("We agree with the Patent Office that the spatial separation between the panels is recited in functional language; however, as we said recently in *In re Swinehart*, ... there is nothing intrinsically wrong with the use of such claim language."); *In re Atwood*, 148 USPQ 203, 210 (CCPA 1966) ("We have here a combination claim and the limitations ignored by the Board as use limitations we think are functional expressions which must be given weight."). In particular, among other replacements of functional language for intent-of-use language, Applicant's claimed "aperture" now includes the functional limitation "configured to allow removal of the external cable without removal of the retainer", which must be considered in determining anticipation. As described previously, Jacobowitz does not teach or suggest this functional limitation.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). Since Jacobowitz does not meet each and every limitation of Applicant's claim 1, per *Verdegaal Bros., Inc., supra*, Jacobowitz cannot be used in formulating an anticipation rejection under 35 U.S.C. § 102.

The Bossard Reference

Bossard discloses a fiber optic splice closure for protecting the splice made into a transmission cable. Bossard does not make up for the deficiencies of Jacobowitz in meeting Applicant's Claim 1. In particular, Bossard also does not teach "an aperture configured to allow removal of the external cable without removal of the retainer". In Bossard, when the closure assembly 15 is assembled, the channel formed between the base 16 and cover 17 cannot be equated with "an aperture configured to allow removal of

the external cable without removal of the retainer” since the fiber optic cables *cannot be removed* without disassembling the closure assembly 15.

Accordingly, Jacobowitz even in combination with Bossard does not meet the limitations of Applicant’s claim 1.

The Gretz Reference

Gretz discloses a cable support which provides a curved surface over which the cabling is laid and provides means to permit separation of individual cables to inhibit their shifting within the support. Gretz does not make up for the deficiencies of Jacobowitz and Bossard in meeting Applicant’s Claim 1. In particular, Gretz also does not teach “an aperture configured to allow removal of the external cable without removal of the retainer”. In Gretz, cables are laid over a curved surface to support the cables. The cable support does not include an ingress, an egress, a guiding path between the ingress and egress, or a retainer or aperture configured to allow removal of the external cable without removing the retainer. Accordingly, Jacobowitz even in combination with Bossard and/or Gretz, does not meet the limitations of Applicant’s claim 1.

The Norris Reference

Norris discloses a cable tray in which cables are hung on hangers. Norris does not make up for the deficiencies of Jacobowitz and/or Bossard and/or Gretz in meeting Applicant’s Claim 1. In particular, Gretz also does not teach “an aperture configured to allow removal of the external cable without removal of the retainer”. Accordingly, Jacobowitz even in combination with Bossard, Gretz, and/or Norris does not meet the limitations of Applicant’s claim 1.

Summary

Accordingly, for all of the above reasons, the Applicant respectfully submits that none of the prior art of record teaches the invention as claimed in Applicant’s Claim 1. Accordingly, the 35 U.S.C. § 102 rejection of claim 1 should be withdrawn and that claim 1 is now in position for allowance.

Claims 2-7 each depend from independent base claim 1 and add further limitations. For at least the same reasons that Claim 1 is not shown, taught, or disclosed by the cited references, Claims 2-7 are likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of claims 2-7 should be withdrawn.

b. Claims 8-18

Amended claim 8 now recites:

An electronic instrument comprising:
a housing;
an electrical connector positioned on a first face of said housing;
a first cable routing channel formed on a second face of said housing, said second face adjacent to said first face of said housing, said cable routing channel comprising:
an ingress in proximity to said electrical connector configured to receive an external cable,
an egress in proximity to a third face of said housing configured to output said external cable,
a guiding path connecting said ingress and said egress,
a retainer configured to retain said external cable in said guiding path when said external cable is routed through said guiding path between said ingress and said egress, and
an aperture configured to allow removal of the external cable without removal of the retainer.

Claim 8 recites similar limitations to claim 1, including “an aperture configured to allow removal of the external cable without removal of the retainer “. For at least the same reasons that Claim 1 is not shown, taught, or disclosed by the cited references, Claim 8 is likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of Claim 8 should be withdrawn.

Claims 9-18 each depend from independent base claim 8 and add further limitations. For at least the same reasons that Claim 8 is not shown, taught, or disclosed by the cited references, Claims 9-18 are likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of claims 9-18 should be withdrawn.

c. Claims 19-20

Amended claim 19 now recites:

A method for routing an external cable attached to an electronic connector mounted on a first face of an electronic instrument to a second face of said electronic instrument, comprising:

providing on said instrument a routing channel from said first face of said electronic instrument to said second face of said electronic instrument, said routing channel comprising an ingress in proximity to said electrical connector configured to receive said external cable, an egress in proximity to a third face of said housing configured to output said external cable, a guiding path connecting said ingress and said egress, a retainer configured to retain said external cable in said guiding path when said external cable is routed through said guiding path between said ingress and said egress, and an aperture configured to allow removal of said external cable without removal of said retainer.

Claim 19 recites similar limitations to claim 1, including “an aperture configured to allow removal of said external cable without removal of said retainer “. For at least the same reasons that Claim 1 is not shown, taught, or disclosed by the cited references, Claim 19 is likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of Claim 19 should be withdrawn.

Claim 20 depends from independent base claim 19 and adds further limitations. For at least the same reasons that Claim 19 is not shown, taught, or disclosed by the cited references, Claim 20 is likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of Claim 20 should be withdrawn.

Conclusion

In view of the foregoing remarks, it is respectfully submitted that none of the references cited by the Examiner taken alone or in any combination shows, teaches, or discloses the claimed invention, and that Claims 1-20 are in condition for allowance. Reexamination and reconsideration are respectfully requested.

Should the Examiner have any questions regarding this amendment, or should the Examiner believe that it would further prosecution of this application, the Examiner is invited to call the undersigned.

Respectfully submitted,



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